

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOICHI SEKI, HIROYUKI SAITO,
and TERUYO HAYAKAWA

Appeal No. 1997-0318
Application 08/135,173¹

ON BRIEF

Before FLEMING, RUGGIERO and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection² of claims 1 through 18, which constitute all the claims

¹ Application for patent filed October 12, 1993.

² An amendment after the final rejection was filed [paper no. 10], however, it was refused entry [paper no. 11]. A second amendment after the final rejection was filed [paper no. 14] and was entered in the record by the Examiner [paper no. 15].

in this application.

The disclosed invention relates to an electronic camera having control data protection means for protecting, from static electricity, data used for operating the camera, including means for temporarily storing the control data when the camera back is opened for loading and unloading the film. The invention is further described by the following representative claim. Claim 2 is reproduced below as representative:

2. A camera, comprising: a cover movable between a closed state and an open state; detecting means for detecting when the cover makes a transition between the closed state and the open state and producing a corresponding detection signal; a data register for storing control data; film sensitivity detecting means for detecting film sensitivity; temporary storing means for temporarily storing the control data; and control means for controlling operation of the camera depending on the control data stored in the data register, the control means including means responsive to the detection signal for transferring the control data from the data register to the temporary storing means when the cover makes a transition from the closed state to the open state and for transferring the control data from the temporary storing means back to the data register when the cover makes the transition from the open state to the closed state so as to protect data from disruption due to static electricity.

The references relied on by the Examiner are:

Haraguchi et al. (Haraguchi)	4,733,265	Mar. 22, 1988
Ishikawa et al. (Ishikawa)	4,783,674	Nov. 8, 1988

Claims 1 through 18 stand rejected under 35 U.S.C. § 103 over Haraguchi and Ishikawa.

Reference is made to Appellants' briefs³ and the Examiner's answer⁴ for their respective positions.

OPINION

We have considered the record before us, and we will reverse the rejection of claims 1 to 18.

The Examiner has rejected all these claims under 35 U.S.C. § 103 as being obvious over Haraguchi in view of Ishikawa.

We first consider the broadest independent, i.e., claim 2. The Examiner states that "Haraguchi et al. shows all claimed structure except 'sensitivity detecting means' or 'resetting means'." [Answer, page 3]. The Examiner notes further that Ishikawa shows the sensitivity means at column 13, lines 41 to 44 and to add such means to Haraguchi would have been obvious. [Id.]

Appellants argue that there is no basis to combine Haraguchi and Ishikawa [brief, pages 14 to 18]. Appellants also argue that the combination of Haraguchi and Ishikawa does not meet the claimed limitations [brief, pages 11 to 14].

The courts have provided us a guidance in determining the propriety of an obviousness

³A reply brief was filed [paper no. 25] and was entered in the record, however, no further response was deemed necessary by the Examiner [paper no. 26].

⁴ We have considered the latest version of the Examiner's answer for our discussion here [paper no. 23].

rejection. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. System, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Here, the Examiner, in our view, is using the invention as a blue print to make the combination to meet the claimed invention. We find nothing in Haraguchi or Ishikawa which mentions, let alone solves, the problem of static electricity affecting the data in the data storage area of a camera. Haraguchi is only concerned with the transfer of data between the temporary storage and the data storage area in the control means, 12 and 13 respectively in figure 2, during the

course of replacing an old battery. No mention is made of any static electricity. Similarly, Ishikawa does not suggest anything about static electricity being a problem in affecting the data in the control means of the camera. The Federal Circuit has stated that “[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). “Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.” Para-Ordnance Mfg. v. SGS Importers Int’l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Therefore, we agree with Appellants that the suggested combination of Haraguchi and Ishikawa is improper.

Even assuming that the combination of Haraguchi and Ishikawa is proper, the Examiner's combination still does not meet the limitation, "the control means including means . . . for transferring the control data . . . so as to protect data from disruption due to static electricity." [Claim 2, lines 9 to 17]. The Examiner contends that “[s]uch a combination [of Haraguchi and Ishikawa] would inherently protect the temporally [sic] stored data because of its responsiveness to the opening and closing of the door (the door providing a physical barrier to static electricity).” [Answer, page 7]. Appellants

counter that the static electricity mentioned in the invention is that which is applied to film sensitivity detecting means, (having DX terminals), of the camera, and the exposure of the DX terminals subjects them to potential static electricity from the human hands as they are used in the opening and closing of the camera cover. Appellants further argue that no such exposure of the DX terminals is contemplated by the opening of the battery cover in Haraguchi [reply brief, pages 7 to 10]. Nor is anything like this disclosed in Ishikawa [Id.]. Therefore, we agree with Appellants that the combination of Haraguchi and Ishikawa, even if proper, does not meet the claimed invention. Thus, we do not sustain the obviousness rejection of claim 2 and, hence, its dependent claims 3 through 18 over Haraguchi and Ishikawa.

Regarding the other independent claim, i.e., claim 1, it, too, contains at least the limitation discussed above. We, therefore, also do not sustain the obviousness rejection of claim 1 over Haraguchi and Ishikawa.

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DECISION

The decision of the Examiner rejecting claims 1 to 18 under 35 U.S.C. § 103 over Haraguchi and Ishikawa is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PARSHOTAM S. LALL)	
Administrative Patent Judge)	

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BRUCE L. ADAMS
ADAMS & WILKS
50 BROADWAY - 31st FLR.
NEW YORK, NY 10004

PSL/dal